REMARKS

In the Office Action mailed on August 8, 2005 the Examiner rejected claims 60, 62-64, and 66-69 and withdrew claims 61 and 65 from consideration. New claims 70 and 71 are presently added and claims 60, 62 and 66 are currently amended. No new matter is presently included in the amended or newly added claims. Reconsideration of the application in view of the remarks set forth below is respectfully requested.

Obviousness-Type Double Patenting Rejection

In the Office Action, the Examiner rejected claims 60, 63, and 64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 14, and 15 of Casciani et al. (U.S. Patent No. 6,662,033) (the '033 patent). The Examiner rejected claims 60, 62, and 66-69 under the judicially created doctrine of obviousness-type double patenting over claims 3 and 5-7 of Casciani et al. (U.S. Patent No. 6,272,363) (the '363 patent). The Examiner rejected claim 63 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of Casciani et al. (U.S. Patent No. 5,421,329) (the '329 patent). Additionally, the Examiner rejected claims 60 and 63 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 9 of the '329 patent.

Although Applicants do not agree with the Examiner's rejection and respectfully assert that amendments to 35 U.S.C. § 1.54 obviate the necessity of a terminal disclaimer on any claims

issuing from an application claiming a priority under 35 U.S.C. § 120, Applicants submit a properly executed terminal disclaimer for each of the references cited under the obviousness-type double patenting rejection. These terminal disclaimers are attached hereto as Appendix A. Applicants respectfully submit that the terminal disclaimer obviates the Examiner's obviousness-type double patenting rejection.

Accordingly, Applicants request that the Examiner withdraw the obviousness-type double patenting rejections of claims 60, 62-64, and 66-69. Further, Applicants request that the Examiner provide an indication of allowance for claims 60, 62-64, and 66-69. Specifically, Applicants direct the Examiner's attention to the fact that the only rejection of independent claim 63 and dependent claims 64 and 67 relate to the alleged obviousness-type double patenting, which has been obviated. Accordingly, claims 63, 64, and 67 are clearly in condition for allowance.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claim 60 under 35 U.S.C. § 102(b) as being anticipated by Shaw (U.S. Patent No. 3,638,640). Additionally, the Examiner rejected claims 60, 62, 66, 68, and 69 under 35 U.S.C. § 102(e) as being anticipated by Chance (U.S. Patent No. 5,402,778). Specifically, the Examiner stated the following:

> Shaw teaches an oximeter that includes emitting light from at least one source (10, 12, 14); detecting light from detectors (47, 49, 51); the detectors are limited to detecting about the 660, 715, and 805 nm wavelengths. (column 2, lines 31-70 of Shaw).
> ...

> Chance teaches an oximeter that uses 754 nm and 816 nm wavelengths, light sources, and a light detector. (Fig. 2 and column 5, lines 3-40 of Chance).

Final Office Action, page 9.

In view of the current amendments, Applicants respectfully traverse. Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims contain even one recitation not found in the cited reference, the reference does not anticipate the claimed subject matter.

Applicants assert that the Examiner's rejections under 35 U.S.C. § 102 are moot in view of the current claim amendments. The cited references fail to disclose exactly what is claimed. For example, independent claim 60 presently recites "detecting light ... the detected light also including a red light spectrum, said red light spectrum having a narrow mean wavelength *between 725 and 745* nanometers." (Emphasis added). In stark contrast, the Shaw reference merely discloses "three semiconductor electroluminescent diodes 9, 11 and 13 arranged to irradiate substantially the same area of the ear 15 of a patient at at least three different narrow-band portions of the electromagnetic radiation spectrum, for example, *about the 660, 715, and 805*

millimicron wavelengths." Shaw, col. 2, lines 33-37 (emphasis added). Also in contrast to the present claim recitations, the Chance reference merely discloses a continuous wave spectrometer that operates at "two wavelengths sensitive to hemoglobin (Hb) and oxyhemoglobin (HbO_2) (e.g., *754 nm and 816 nm*)." Chance, col. 5, lines 19-23 (emphasis added).

In view of the arguments set forth above, Applicants respectfully request that the Examiner withdraw the rejections of claims 60, 62, 66, 68, and 69. Further, Applicants request that the Examiner provide an indication of allowance for claims 60, 62, 66, 68, and 69.

New Claims

As set forth above, the Applicants added new claims 70 and 71. For the reasons discussed in detail above and other claim features, the Applicants believe these claims are patentable over the cited references and in condition for allowance. Therefore, the Applicants request that the Examiner allow the new claims 70 and 71.

Conclusion

If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

General Authorization for Extensions of Time

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefor. Furthermore, Applicants authorize the Commissioner to charge the appropriate fee of *$120.00* for the *one-month* extension of time, and any additional fees which may be required, to the credit card listed on the attached PTO-2038. However, if the PTO-2038 is missing, if the amount listed thereon is insufficient, or if the amount is unable to be charged to the credit card for any other reason, the Commissioner is authorized to charge Deposit Account No. 06-1315; Order No. TYHC:0095-3/FLE.

Respectfully submitted,

Date: December 8, 2005

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